

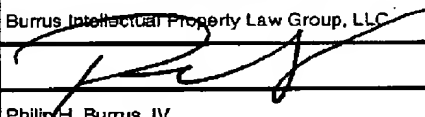
PTO/SB/21 (39-04)

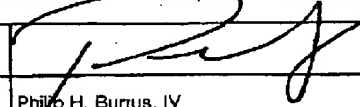
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/817,067	<b>RECEIVED</b> <b>CENTRAL FAX CENTER</b> <b>JUN 01 2006</b>
	Filing Date	July 18, 2000	
	First Named Inventor	Daniel Papalia	
	Art Unit	3629	
	Examiner Name	Igor Borrisov	
Total Number of Pages in This Submission:	15	Attorney Docket Number	EN11111

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
<b>Remarks</b> This replacement Appeal Brief is in response to an Order Returning Undocketed Appeal to the Examiner mailed May 25, 2006.		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Burrus Intellectual Property Law Group, LLC	
Signature		
Printed name	Philip H. Burrus, IV	
Date	6/1/2006	Reg. No. 45,432

CERTIFICATE OF TRANSMISSION/MAILING		
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Typed or printed name	Philip H. Burrus, IV	Date 6/1/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No: 09/617,067  
Examiner: Borrisov, Igor  
Art Group: 3629  
Reference No.: EN11111  
Appn. Filed: July 16, 2000  
Applicants: Papalia, Dan  
Morris, Doug  
Title: System and Method to Control Distributed Power Network

June 1, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia

Sir:

This replacement Appeal Brief is being filed from an Order Returning Undocketed Appeal to the Examiner mailed on May 25, 2006. Only one copy of this appeal brief is being filed, in accordance with the requirements of MPEP §1205.02. As the Appeal Brief filing fee was paid with the initial filing, Applicants believe no additional fees to be due at this time. The Commissioner is hereby authorized to charge any overlooked fees to Deposit Account Number 50-3608.

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via facsimile to 571-273-8300 on June 1, 2006.

Printed Name: Philip L. Burrus, IVSigned Name: 

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**REAL PARTY IN INTEREST:**

The real party in interest is Motorola, Inc., 100% interest assignee of record, whose mailing address is 1303 E. Algonquin Road, Schaumburg, Illinois.

**RELATED APPEALS/INTERFERENCES:**

This is the only pending appeal of this application. There are no pending interferences to the best knowledge of the Applicants.

**STATUS OF CLAIMS:**

Claims 1, 2, 4-8, 10-19, 21 and 22 are pending in the application. Claims 1, 2, 4-8, 10-19, 21 and 22 have been and currently stand rejected under §103(a).

**STATUS OF AMENDMENTS:**

The most recent amendment was mailed on June 8, 2004 in response to an Office Action (OA) mailed April 13, 2004. No subsequent amendments have been submitted by Applicants.

**SUMMARY OF CLAIMED SUBJECT MATTER:**

Briefly, this invention is a distributed generation network control system and method. The term "distributed generation" refers to a network of power machines, like electricity generating fuel cells, for example that are distributed to multiple users. In the present invention, a system manager (referred to in the present application as the "Aggregator") provides a power machines to a plurality of customers, generally free of charge. In exchange for providing a cost free power machine to each customer, the Aggregator retains the ability to turn the power machines on and off from a remote location.

The Aggregator actuates the power machines whenever the primary power system, like the utility power grid, is down. This "grid or locally actuated power machine" supply provides the customer with uninterrupted power. However, in addition to actuating the power machines at grid interruptions, the Aggregator additionally monitors the market price of electricity and the market price or fuel for the power

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machines. For instance, if the power machine is a fuel cell, it may operate from a hydrocarbon fuel source like natural gas. When the difference between the price of electricity and the price of power machine fuel is sufficiently different, the Aggregator may elect to actuate the power machines and supply electricity not only to the customer but also back to the grid. Prior to doing so, though, a local control circuit must evaluate local data (like the present load) to determine whether there is excess capacity to sell to the grid. If there is not enough spare capacity, the local control circuit will override the Aggregator so as not to leave the customer in the dark.

Turning specifically to independent claim 1, a system of power machines includes a plurality of the power machines. Each power machine has control circuitry (e.g. 210, page 5, lines 18-26) with which, for example, the Aggregator (103, page 7, line 19 through page, 9, line 9) may actuate the machines. A remote means for actuating the machines, which may be the Aggregator, includes a means for monitoring the price of electricity, a means for monitoring the price of other fuels, such as hydrocarbons, and mechanism for calculating a difference between the price of electricity and the other fuels. When the remote monitor determines, for example, that the price delta is sufficiently high, the remote monitor sends an actuation signal to the local power circuitry. This local power circuitry then evaluates local data, such as whether the grid is operational. Where the situation is conducive for actuation, the local circuitry actuates the corresponding power machine.

Turning now to independent claim 10, this claim recites a similar system. A plurality of power machines having control circuitry is included. Here the control circuitry includes a mechanism for monitoring local power statuses and information, as well as electricity generation factors. One example of an electricity generation factor may be whether the power grid is operational. As with claim 10, when a remote system transmits an actuation signal, the control circuit first evaluates the local data and then, if appropriate, actuates the machine. However, where an override signal comes from the remote system, the control circuitry actuates the machine without the evaluation of local data.

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**GROUND OF REJECTION TO BE REVIEWED ON APPEAL:**

**Ground 1**

Whether claims 1, 2, 4-8, 10-19 and 22 are patentable under §103(a) over Chasek (US Pat. No. 5,237,507) in view of Edelman et al. (US Pat. No. 6,281,601).

**Ground 2**

Whether the language "...omits evaluation of the local data upon receipt of the override signal..." recited in claim 10 is non-functional language.

**Ground 3**

Whether claim 21 is patentable under §103(a) as being unpatentable over Chasek in view of Edelman, further in view of Norris et al. (US Pat. No. 5,510,780).

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**ARGUMENT:**

**Comments on Grouping of Claims:**

Claims 2, 4-9 all depend from claim 1. Claims 11-19 all depend from claim 10. For the purposes of Issue 1, Applicants respectfully submit that claims 1,2 and 4-9 may be grouped together, with claim 1 as the exemplary claim, and claims 10-19 may be grouped together, with claim 10 as the exemplary claim.

Regarding Issue 2, there is only one claim (claim 21), so no grouping is necessary.

**Ground 1**

The most recent Office Action (OA) rejects claims 1, 2, 4-8, 10-19 and 22 under §103(a) as being unpatentable over Chasek (US Pat. No. 5, 237,507) in view of Edelman et al. (US Pat. No. 6,281,601), herein after "Edelman". Specifically, with respect to claim 1, the OA submits that Chasek teaches the limitations of claim 1 except for a means for actuating a power machine. The OA submits that Edelman teaches a system for actuating a networked power generation system and that it would be obvious to one of ordinary skill in the art at the time the invention was made to combine Chasek and Edelman to achieve Applicants' invention.

Applicants respectfully traverse this rejection. Specifically, Applicants respectfully submit that the combination of Chasek and Edelman fails to teach all of Applicants' claimed limitations. According to MPEP §2142, "The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully submit that neither the references, the OA, nor the most recent "Response to Arguments" section indicates the where in the references the following limitations are taught:

CLAIM 1: The combination fails to teach control circuitry that evaluates local data after the receipt of a control signal and before actuation of the power machines. By contrast Edelman teaches a remote power meter as providing a control signal to the

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power machine. See e.g. col. 5, lines 18-28 and FIG. 5. Power meters measure power and may be used as sources of data, but do not include means for evaluating data like the price of electricity and hydrocarbons upon the receipt of a command signal. Chasek teaches a central utility computer that monitors information like temperature and demand. See e.g. FIG. 1. This is not control circuitry coupled to the power machine for evaluating local data after receiving a control signal from a central computer.

Applicants are unable to find any indication of these elements in either the OA or the references themselves. The most recent OA does not indicate where these limitations are found in the references. Applicants respectfully note that according to MPEP §2142, "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

Applicants very respectfully submit that no prima facie case of obviousness has been made, as the combination of references, as set forth in the OA, fails to teach all of Applicants' claimed limitations. Applicants therefore respectfully request that the §103 rejection be withdrawn.

CLAIM 10: In addition to the limitations noted with respect to claim 1, Applicants respectfully submit that neither of the references teaches the control circuitry omitting evaluation of the local data upon receipt of the override signal. There is no indication in Edelman that the power meter stops metering power upon the receipt of an override signal. Similarly, there is no indication in Chasek that the central utility computer omits evaluation of local data like temperature and demand upon the receipt of an override signal.

The OA does not indicate where, in either reference, the limitation can be found. As such, Applicants very respectfully submit that no prima facie case of obviousness has been made. Applicants respectfully request that the §103 rejection is overcome.

#### Ground 2

In the most recent OA, the Examiner submits that the clause "...omits evaluation of the local data upon receipt of the override signal..." recited in claim 10 is non-

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functional language, and is thus not to be given weight when comparing the claim to the prior art. Applicants respectfully traverse this assertion.

According to MPEP §2173.05(g), functional language is defined as "...an attempt to define something by what it does, rather than by what it is..." MPEP §2173.05(g) goes on to state that functional language is used in "...association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step." Emphasis added.

Applicants respectfully submit that the omission of the evaluation of local data is in fact functional language, in that it defines a particular capability of the control circuitry. Applicants respectfully submit that the omission of evaluation of local data by the control circuitry defines the control circuitry by what it does, and is thus, by definition, functional language because the act of omitting is an act that the control circuitry "does." In other words, omission of evaluation is something done by the control circuitry, and is thus functional.

The OA cites two cases, *In re Gulack* and *In re Dembiczak* in justifying the non-functional language assertion. In the former, the non-functional language at issue is printing on a band. The court states that the language printed has no relationship to the digits printed on the band and the band itself. In the latter, discusses a holiday trash bag with a pumpkin face being non-obvious over conventional trash bags, and fails to mention functional language on the page (1000) indicated by the OA. Applicants respectfully request clarification as to how either of these cases stands for the proposition that the act of omitting an evaluation when a signal is received is not an action, i.e. something the control circuitry does. Quite to the contrary, an affirmative step of not evaluating data is an action, and is thus functional.

Applicants respectfully submit that this is a functional clause, and not merely descriptive, and should be read into the claim.

### Ground 3

Claim 21 is rejected under §103 as being unpatentable over Chasek in view of Edelman, further in view of Norris et al. (US Pat. No. 5,510,780), herein after "Norris". Specifically, the OA states that Chasek and Edelman teach the limitations of claim 21



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except for licensing of power machines. The OA submits that Norris teaches controlling power generation equipment wherein the power machines are leased.

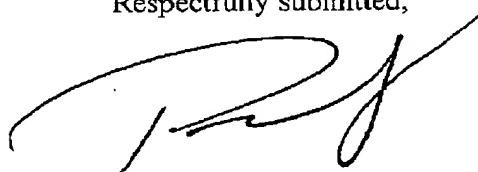
Applicants rely on the comments above regarding claim 10, as Applicants respectfully submit that no prima facie case of obviousness has been made with respect to independent claim 10 (from which claim 21 depends). Specifically, Applicants respectfully submit that none of the references teach the control circuitry omitting evaluation of the local data upon receipt of the override signal. As such, Applicants respectfully submit that the §103 rejection is overcome.

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**CONCLUSION**

For the above reasons, Applicants believe the specification and claims are in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is in condition for allowance, for which they respectfully submit.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'PHB', is written over a horizontal line.

Philip H. Burrus, IV

Attorney for Applicants

Registration No.: 45,432

404-797-8111

404-880-9912 (fax)

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## CLAIMS APPENDIX

### Listing of Claims:

1. (Previously Presented) A system for operating power machines, comprising:
  - a. a plurality of power machines, the power machines each comprising control circuitry coupled thereto; and
  - b. a remote means for actuating the power machines comprising:
    - i. a means for monitoring a market price of electricity;
    - ii. a means for monitoring a market price of hydrocarbon fuels; and
    - iii. a means for calculating the difference between the market price of electricity and the market price of hydrocarbon fuels;wherein after the remote means for actuating the power machines transmits an actuation signal to the power machines, the control circuitry evaluates local data stored therein prior to actuating the power machines.
2. (Previously Presented) The system of claim 1, where in the means for actuating the power machine network comprises means for transmitting an actuation signal across a communications means to a power machine.
3. (Canceled)
4. (Previously Presented) The system of claim 2, wherein the actuation signal comprises a remote override signal causing the power machine to turn on or turn off.
5. (Original) The system of claim 4, further comprising a means for reading data from a meter.
6. (Original) The system of claim 5, further comprising a means for reading data related to the operational performance of the power machine.

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7. (Original) The system of claim 6, further comprising a means for reading the local energy rate structure.

8. (Original) The system of claim 7, further comprising a means to calculate the load demand and to print and prepare a billing statement.

9. (Canceled)

10. (Previously Presented) A system for generating power machine actuation data, comprising:

- a. a plurality of power machines, the power machines each comprising control circuitry coupled thereto, wherein the control circuitry comprises:
  - i. a means for monitoring local data; and
  - ii. a means of considering electricity generation factors;
- b. a remote means for actuating the power machines comprising:
  - i. a means of comparing the market price of electricity and hydrocarbon fuel;
  - ii. a means of transmitting an actuation signal; and
  - iii. a means of transmitting an override signal,wherein the control circuitry evaluates the local data after receipt of the actuation signal;  
further wherein the control circuitry omits evaluation of the local data upon receipt of the override signal.

11. (Original) The system of claim 10, further comprising a means for aggregating power to sell on a power market.

12. (Original) The system of claim 11, further comprising a means for generating a billing statement.

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13. (Original) The system of claim 12, wherein the electricity generation factor is selected from the group consisting of market rate structure, peak shaving information, load shedding information and information relating to the ability to sell power to the grid.

14. (Original) The system of claim 13, wherein the system operates in an environment selected from the group consisting of a traditional environment, a transitional environment, and a competitive environment.

15. (Original) The system of claim 14, further comprising a means to calculate the load demand and to print and prepare a billing statement.

16. (Original) The system of claim 15, further comprising a means for selling power to the grid.

17. (Original) The system of claim 16, wherein the system participates in load shedding.

18. (Original) The system of claim 16, wherein the system participates in peak shaving.

19. (Original) The system of claim 16, wherein the data is selected from the group consisting of electricity prices, hydrocarbon prices, resource rate structure, power machine efficiency, power machine operating characteristics, futures prices, environmental data, regulatory rules, load demand, and weather.

20. (Canceled)

21. (Previously Presented) The system of claim 15, further comprising a distributor capable of licensing the power machines.

22. (Previously Presented) The system of claim 16, wherein the distributor monitors the operational condition of the power machines.

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**EVIDENCE APPENDIX**

There are no new evidentiary submissions included with this brief.

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### **RELATED PROCEEDINGS INDEX**

To Applicants' knowledge, no decisions have been rendered by either board or court having appropriate jurisdiction, other than Examiners in the Art Group listed above, in this case.